

Docket No.: 05-00588-02/AB-349U

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Remarks**I. REJECTION UNDER 35 U.S.C. § 102****A. The Rejection**

Claims 23-27 and 29-41 were rejected under 35 U.S.C. § 102(a) as anticipated by Oh et al., "Deep Brain Stimulator Electrodes Used for Lesioning: Proof of Principle" Neurosurgery, Vol. 49, No. 2 (August 2001) pages 363-369 ("the Oh article"). As demonstrated below, the Oh article is disqualified as prior art under 35 U.S.C. 102(a). Reconsideration and withdrawal of the rejection is respectfully requested.

B. Effective Filing Date of Claims 23-41

Applicant respectfully submits that pending claims 23-41 are, at a minimum, entitled to the July 18, 2002 filing date of the provisional application to which the present application claims priority. As such, the Oh article, which is dated August 2001, is only available as a reference under 35 U.S.C. § 102(a).¹

C. Reference is Publication of Applicant's Own Invention

Applicant submits herewith a 37 CFR §1.132 declaration to show that the Oh article is a publication of Applicant's own invention. In addition, the declaration affirms that the inventorship of the present application is correct and that the Oh article discloses subject matter derived from the Applicant rather than invented by the authors of the Oh article, notwithstanding the authorship of the article. As such, the Oh article is no longer applicable and cannot be used as a reference in a rejection under 35 U.S.C. § 102(a). [See MPEP §715.01(c)(1) and MPEP §716.10.]

¹ The present Office action indicates in two places that the Oh article was dated August 2000, but Applicant assumes this is a typographical error, as the rejection is under 35 U.S.C. 102(a), not 102(b), and because the article is actually dated August 2001.

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II. REJECTION UNDER 35 U.S.C. § 103**A. The Rejection**

Claim 28 was rejected under 35 U.S.C. § 103(a) as unpatentable over the Oh article in view of Streatfield et al. (WO 02/068042). As demonstrated earlier and in the attached Rule 132 declaration, the Oh article is disqualified as prior art under 35 U.S.C. 102(a). Hence, the Oh article is not available as a reference under 35 U.S.C. § 103(a). Reconsideration and withdrawal of the rejection is respectfully requested.

B. Discussion Concerning Claim 28

In light of the attached Rule 132 declaration and above statements concerning attribution, the Oh article cannot properly be relied upon to reject claims in the present application under 35 U.S.C. § 103(a). Accordingly, the rejection of claim 28 is improper and Applicant requests that this rejection be withdrawn.

Applicant therefore submits that claims 23-41 are in condition for allowance.

III. CLOSING REMARKS

In view of the foregoing and the attached Rule 132 declaration, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (661) 362-1906 to discuss the steps necessary for placing the application in condition for allowance.

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The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0648. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Date

2006 Nov 09

Please direct all written inquiries to:
Bryant R. Gold
Advanced Bionics Corporation
25129 Rye Canyon Road
Valencia, California 91355
Fax: (661) 362-1507

Respectfully Submitted,

Laura Haburay Bishop
Laura Haburay Bishop
Reg. No. 47,424
Agent for Applicant

Please direct all telephone inquiries to:
Laura Haburay Bishop
Telephone: (661) 362-1906